

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOLGER KUEHNER

Appeal No. 97-2502
Application 08/358,353¹

HEARD: February 4, 1998

Before WILLIAM F. SMITH, ELLIS, and TORCZON, **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 14 through 37. Claim 29 was withdrawn from appeal by the appellant in the Reply Brief (Paper No. 17) filed April 3, 1997. Accordingly, we will consider the issues as they apply to claims 14 through 28 and 30 through 37.

¹ Application for patent filed December 19, 1994.

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Claims 14 and 31 are illustrative of the subject matter on appeal and read as follows:

14. A process for preparing a sterile milk pap comprising mixing heated milk with a cereal product to swell the cereal product during the mixture so that vegetative microbes are destroyed to obtain a heat-treated mixture, degassing the heat-treated mixture to obtain a degassed mixture to avoid oxidation of the mixture, heating the degassed mixture under ultra-high-temperature conditions to sterilize the degassed mixture to obtain a sterilized, degassed mixture and then, cooling the sterilized degassed mixture.

31. A sterile milk pap comprising, by weight, a sterile, degassed mixture of between 50% and 80% milk and of between 5% and 10% swollen cereal product.

The references relied on by the examiner are:

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| Stevens et al. (Stevens) | 1,241,163 | Sep. 25, 1917 |
| Billerbeck et al. (Billerbeck) | 3,506,447 | Apr. 14, 1970 |
| Dimler et al. (Dimler) | 5,378,488 | Jan. 03, 1995 |

Hall et al. (Hall), **Milk Pasteurization**, The Avi Publishing Company, Inc., pp. 107, 117 (1968).

Claims 14 through 28 and 30 through 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dimler in view of Billerbeck, Stevens, and Hall.²

² On p. 3 of the Answer, the examiner states that claims 14 through 28 and 30 through 37 stand rejected under 35 U.S.C. § 103(a) over the applied prior art. However, on p. 5 of the Answer, she treats claim 29 as if it were included in the rejection. Moreover, when the appellant attempted to withdraw claim 29 from appeal on p. 3 of the Reply Brief, the examiner refused stating that claim 29 can not "be withdrawn at this time." Supplemental Answer, p. 1. Regardless of the examiner's original intention with respect to claim 29, the appellant's withdrawal of this claim from appeal resolves the issue. That

Having carefully considered the entire record which includes, *inter alia*, the appellant's Brief (Paper No. 12), Reply Brief (Paper No. 14) and supplemental Reply Brief (Paper No. 17), as well as the examiner's Answer (Paper No. 13), supplemental Answer (Paper No. 16) and second supplemental Answer (Paper No. 19), we **reverse** the rejection with respect to the method claims, claims 14 through 28, and **affirm** with respect to the product and product-by-process claims, claims 30 through 37.

As an initial matter we note the appellant's statement on p. 5 of the Brief that the claims do not stand or fall together. 37 CFR § 1.192(c)(7) and (8). As we understand it, the appellant has grouped method claims 15 and 16 separate from method claims 14 and 17 through 28. In addition, the appellant has grouped the product-by-process claims 29 and 30 together, and the composition claims 31 through 37 together. Brief, pp. 3 and 9. Accordingly, we will consider the issues as they apply to claims 14, 15, 16, 30 and 31, which are representative of each of the appellant's groups.

is, contrary to the contention on p. 1 of the supplemental Answer, the appellant is entitled to withdraw the claim from appeal. Thus, although still pending in the application, claim 29 is not on appeal before this merits panel. Therefore, upon return of this application to the corps, the examiner should clarify the record as to the status of this claim.

Turning first to method claim 14, we find that it is directed to a method of preparing a sterile milk pap which requires the performance of a specific sequence of steps. Although it appears that each of the claimed steps was known in the art, the examiner has not provided any reasons, based on factual evidence, as to why the specific sequence of events described in representative claim 14 would have been obvious to one of ordinary skill in the art at the time the application was filed. Rather, the examiner's overall position is that because those of ordinary skill in the art routinely perform various combinations of the claimed steps in the preparation of different food products, the claimed sequence would have been **prima facie** obvious. However, from a fair review of the applied prior art, it is difficult to discern on which basis the examiner reached this conclusion. We caution the examiner that a conclusion of obviousness must be based on facts and not unsupported generalities. **In re Freed**, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970); **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Accordingly, we reverse the rejection of claims 14 and 17 through 28.

Since dependent claims 15 and 16 manifestly require the same specific sequence of preparatory steps as base claim 14, it

follows that the rejection of these claims is reversed for the reasons discussed above.

As to the product claims, we find that representative claim 31 is directed to a sterile, degassed milk pap which comprises between 50% and 85% milk and between 5% and 10% swollen cereal product. Here, we concur with the examiner that the product described in claim 31 would have been obvious over the applied prior art. We direct attention to the Stevens patent which discloses a sterile milk pap comprising milk and rice. The composition described by Stevens differs from the composition described in claim 31 in at least two significant aspects- (1) the presence of oxygen, and (2) the amounts of milk and cereal product required.

As to the oxygen content, i.e., degassing, such processing does not alter the food product *per se*, but rather it merely "avoid[s] oxidation of the product." Specification, p. 2, lines 37-39. Moreover, the prior art of record indicates that removal of oxygen from a food product; e.g., vacuum packaging, to avoid oxidation of that product was conventional in the art at the time the application was filed.³ So conventional, in fact, that

³ At the oral hearing held February 4, 1998, counsel did not disagree that at the time of the present invention, the degassing of food products was known and conventional in the art.

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Dimler does not even find it necessary to state the reason for degassing the milk-based infant formula described in the patent. Dimler, col. 2, lines 56-57.

As to the differences in the amount of milk and cereal product present in the claimed and prior art compositions, we find that Stevens discloses that the proportions of the referenced constituents are determined by consumer preference. Stevens, col. 1, lines 31-36. Depending on the desired consistency, one of ordinary skill in the art would recognize when to add more or less of the claimed ingredients. Thus, in our opinion, the concentration of the ingredients in a milk pap is merely a result effective variable, the optimization of which is "ordinarily within the skill of the art." *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Accordingly, we conclude that the composition described in claim 31 would have been obvious to those of ordinary skill in the art at the time the application was filed.

As to claim 30, we find that the examiner has correctly characterized the claim as being in a product-by-process format. Answer, p. 5, para. 1. It is well established that with respect to product-by-process claims, patentability depends on the product and not on the process by which it is made. *In re*

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Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985)("[i]f the product in a product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process"). Here, we find no difference between the compositions described in claims 30 and 31. Accordingly, for the reasons discussed above with respect to claim 31, we hold that the product of claim 30 would have been obvious to one of ordinary skill in the art at the time the application was filed.

The decision of the examiner is affirmed in part.

No time period for taking subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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| WILLIAM F. SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOAN ELLIS |) | |
| Administrative Patent Judge |) | APPEALS AND |
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